

REMARKS

Claims 1-30 are pending in the application; claims 17-30 are withdrawn pursuant to a restriction requirement. It is noted that no rejections under 35 U.S.C. §§ 102-103 are raised against claims 8 and 16. Favorable reconsideration in light of the remarks that follow is respectfully requested.

I. The Amendments

The claims are amended to disclaim the compounds having cyclohexyl and allyl groups as possibilities for R⁷ and R⁸ when the remaining R groups are hydrogen.

II. Objection to the Specification

The first page of the Specification is amended to include the required priority information. The instant application is the U.S. National phase of a PCT application.

III. Rejection of Claims 1-16 Under 35 U.S.C. § 112, Second Paragraph

The claims are rejected for vagueness due to the use of variable "n" in several formulae. Independent claims 1 and 9 are divided into several subparts designated by lower-case roman numerals. The variable n is replaced in each subpart as follows:

(vii) p; (viii) q; (ix) r; (x) s; (xi) t; (xii) u; (xiii) v; (xiv) w; (xv) x.

Further, the claims have been amended such that the variable m is only used once in subpart (xv). Appropriate correction is also made to dependent claims. Claim 13 is amended to have a closed parenthesis at the end of the claim. The amendments merely replace generic variable with other generic variables and do not introduce any new subject matter. Therefore, Applicant's representative believes that the rejection is moot.

IV. Rejection of Claims 1-7 and 9-15 Under 35 U.S.C. § 102(a)

Claims 1-7 and 9-15 stand rejected under 35 U.S.C. § 102(a) over Kano et al (Tetrahedron symmetry).

A rejection under 35 U.S.C. § 102(a) can be “overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work.” MPEP § 2132.01. “An uncontradicted ‘unequivocal statement’ from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982).” MPEP § 716.10. The accompanying Declaration under 37 C.F.R. § 1.132 states that the authors of the Kano et al reference were working under the direct control and supervision of the inventor of this Application, Keiji Maruoka, in an academic laboratory. As such, the accompanying declaration shows that the Kano et al reference is not “by another” and is not citable under 35 U.S.C. § 102(a).

Therefore, it is respectfully requested that the rejection of claims 1-7 and 9-15 under 35 U.S.C. § 102(a) be withdrawn.

V. Rejection of Claims 1-7 and 9-15 Under 35 U.S.C. § 102(b)

Claims 1-7 and 9-15 stand rejected under 35 U.S.C. § 102(b) over Abbot et al (Analyst).

The compound shown as Compound XV has two cyclohexyl groups on the quaternary N center. The independent claims are amended to disclaim compounds having R⁷ and R⁸ as cyclohexyl groups where the remaining R¹-R⁶ and R^{1'}-R^{6'} substituents are hydrogen and the counter ion is Br⁻ or I⁻. As such, the compound apparently disclosed in Abbot et al is not within the genus recited in the independent claims.

Therefore, it is respectfully requested that the rejection of claims 1-4 under 35 U.S.C. § 102(b) be withdrawn.

VI. Rejection of Claims 1-4 Under 35 U.S.C. § 102(b)

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) over Fitts et al (JACS).

The compound shown as Compound XV has two allyl substituents (propene) on the quaternary N center. The independent claims are amended to disclaim compounds having R⁷ and R⁸ as allyl groups where the remaining R¹-R⁶ and R^{1'}-R^{6'} substituents are hydrogen and the counter ion is Br⁻ or I⁻. As such, the compound apparently disclosed in Fitts et al is not within the genus recited in the independent claims.

Therefore, it is respectfully requested that the rejection of claims 1-4 under 35 U.S.C. § 102(b) be withdrawn.

VII. Rejection of Claims 1-4 Under 35 U.S.C. § 102(b)

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) over Beilstein (Reg. number 4927823).

The compound shown in Beilstein (Reg. number 4927823) has two allyl substituents on the quaternary N center. The independent claims are amended to disclaim compounds having R⁷ and R⁸ as allyl groups where the remaining R¹-R⁶ and R^{1'}-R^{6'} substituents are hydrogen and the counter ion is Br⁻ or I⁻. As such, the compound apparently disclosed as Beilstein (Reg. number 4927823) is not within the genus recited in the independent claims.

Therefore, it is respectfully requested that the rejection of claims 1-4 under 35 U.S.C. § 102(b) be withdrawn.

VIII. Claim Objections

The Examiner objects to claims 4 and 12 as being improper under 37 CFR § 1.75(c). Claim 4 is amended to depend from independent claim 1 and claim 12 is amended to depend from independent claim 9. Therefore, Applicant's representative believes claims 4 and 12 are no longer multiple dependent and properly depend from claims 1 and 9, respectively.

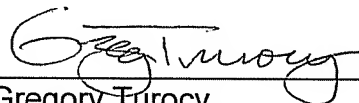
IX. Petition for Extension of Time

A request for a one-month extension of time is hereby made. Payment is made *via* the EFS filing system.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
TUROCY & WATSON, LLP



Gregory Turocy
Reg. No. 36,952

57th Floor, Key Tower
127 Public Square
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731